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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,191	01/25/2005	Hugh James O'Donnell	60469-194;IT-5025	1477
26584	7590	01/09/2009	EXAMINER	
OTIS ELEVATOR COMPANY INTELLECTUAL PROPERTY DEPARTMENT 10 FARM SPRINGS FARMINGTON, CT 06032			GRAY, JILL M	
		ART UNIT		PAPER NUMBER
		1794		
		MAIL DATE		DELIVERY MODE
		01/09/2009		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,191	O'DONNELL, HUGH JAMES	
	Examiner	Art Unit	
	Jill Gray	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 October 2008.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4 and 6-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4 and 6-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5, 7-8, 10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Baranda et al., US 2003/009252 A1 (Baranda).

Claims 13 and 14 are product-by-process claims. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” MPEP 2113

Baranda discloses an elevator belt assembly comprising a plurality of cord within a jacket and a method of making, said method comprising aligning the cords in a desired alignment, tensioning the cords and applying a jacket to the cords during the tensioning process, as required by claims 1, 7, and 13. See [0034]. The jacket is a urethane, per claims 5, 10 and 14, and the belt has limited stretch as required by claim 8. See [0009], [0020], [0029] and [0034].

Therefore the teachings of Baranda anticipate the invention as claimed in present claims 1, 5, 7-8, 10 and 13-16.

3. Claims 7-10 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by PCT Patent Publication WO 01/14630 A1 (hereinafter Prewo).

Claims 13 and 14 are product-by-process claims. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” MPEP 2113

Prewo teaches a tension member for an elevator comprising organic fibers and steel fibers encased in a polyurethane jacket. See page 3, lines 7-14 and page 5, line 3.

Accordingly, the teachings of Prewo anticipate the invention as claimed in present claims 7-10 and 13-15.

4. Claims 1-4, 7-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Lambert 1,412,310.

Lambert discloses a belt and method for forming said belt comprising longitudinally extending cords in a selected arrangement under tension and stretching said cords, and applying a selected jacket material to the cords to encase the cords in the jacket while the cords remain stretched within the jacket as required by present claims 1, 7 and 13. It should be noted that the preamble language of “elevator belt assembly” is drawn to the future intended use of the belt and is not construed to be limiting. See entire document, and in particular, lines 15-21. The cords are stretched to their approximate limit of elongation, which necessarily results in a belt assembly having limited elastic stretch, as required by claim 8 and a the cords being tensioned using a

load corresponding to a desired percentage of a breaking strength of the cords, per claim 3 and the load corresponding to at least approximately 10% of the cord breaking strength, as required by claims 4 and 12. Applicants should note that the limitation of claim 3 is not specific and it is the examiner's position that in the absence of a clear defined percentage, any load necessarily corresponds to "a desired percentage of a breaking strength of the cords." Also, claim 12 is a product claim, wherein limitations drawn to the process of making add no patentable weight. Claim 2 contains limitations drawn to assumptions based upon the future intended use of the belt and is not specific. In this regard, Lambert discloses that the layer of cord is laid while under stress or tension of desired degree and preferably the tension of the members is such as to substantially prevent further elongation of the belt after it has been finished. This teaching anticipates the method of claim 2 and claim 11. However, claim 11 is a product claim, wherein limitations drawn to the process of making add no patentable weight. See lines 63-69. Regarding claim 9, Lambert teaches that the cords can be rubberized, or more specifically, "making the cords using a synthetic material" or "the cords comprise a synthetic material." Regarding claim 13, this claim is a product-by-process claim. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." MPEP 2113.

Therefore, the teachings of Lambert anticipate the invention as claimed in present claims 1-4, 7-9, and 11-13.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-3, 5-6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over PCT Patent Publication WO 01/14630 A1 (hereinafter Prewo) in view of Roberts, 3,441,641.

Prewo is as set forth above and teaches a tension member for an elevator comprising organic fibers and steel fibers because the combined organic and steel fibers result in a shared load that provides significantly enhanced properties. See page 3, lines 20-26. In addition, Prewo teaches that the tension member includes individually load carrying cords, strands and/or wires encased in a common layer of coating but does not teach the specific method steps associated therewith. Roberts teaches an elevator assembly belt formed by the method comprising positioning and tensioning a plurality of longitudinally extending members in a mold, closing the mold and applying a selected material over the tensioned members, whereby said process ensures the tension members remain straight and parallel with respect to each other and results in an elevator belt assembly with a high degree of flexibility and reduced strain. It would have been obvious to one having ordinary skill in the art to form the tension member taught by Prewo by using a method that includes aligning the cords, tensioning the cords and applying a jacket material to the cords, as taught by Roberts to product a

material having a high degree of flexibility and reduced strain and wherein the tension members remain straight and parallel. Claim 2 contains limitations drawn to assumptions based upon the future intended use of the belt and are not specific and claim 11 is a product claim, wherein limitations drawn to the process of making add no patentable weight. Nonetheless, Prewo and Roberts are both drawn to the formation of tension members and belts to be used in an elevator assembly system. The skilled artisan during routine experimentation would have been reasonably motivated to tension the cords using a load that corresponds to that which would result in the safe operation of the car and counterweight. As to claim 3, applicants should note that the limitation of claim 3 is not specific. Accordingly, it is the examiner's position that in the absence of a clear defined percentage any load necessarily corresponds to "a desired percentage of a breaking strength of the cords." Regarding claim 5, Prewo teaches that the jacket material can be urethane. As to claim 6, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make an elevator belt assembly by including cords made of a synthetic material in order to obtain the efficacious properties associated therewith.

Therefore, the teachings of Prewo would have rendered obvious the invention as claimed in present claims 1-3, 5-6, and 11.

Response to Arguments

7. Applicant's arguments filed October 14, 2008 have been fully considered but they are not persuasive.

Applicants argue that there is nothing in the Baranada reference that discusses or suggests stretching cords for purposes of lengthening them, further arguing that the tension is not sufficient to stretch the cords in Baranda in a manner consistent with how the cords in the pending claims are stretched.

In this regard, it is the examiner's position that any degree of stretching would necessarily increase the length of the cord. Also, applicants' claims are not specific as to any amount or degree that the length is increased. Accordingly, the examiner's position remains that the teachings of Baranda anticipate the invention as claimed.

Applicants argue that there is nothing in the Prewo reference that is a teaching or suggestion regarding keeping cords stretched without any external load applied to a belt assembly.

In this regard, and as set forth previously, it is the examiner's position that any degree of stretching would necessarily increase the length of the cord. Also, applicants' claims are not specific as to any amount or degree that the length is increased. Accordingly, the examiner's position remains that the teachings of Prewo anticipate the invention as claimed.

Applicants argue that Prewo in view of Roberts does not provide a *prima facie* case of obviousness, and that even if the proposed combination could be made, there is nothing that corresponds to or suggests stretching cords in a manner that increases a length of the cords as recited in applicants' claims.

In response thereto, the examiner's position is as set forth above and incorporated herein.

No claims are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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